

REMARKS

Claims 1-27 are outstanding. No claims have been canceled or added. Claims 1-22 have been withdrawn. Reconsideration and allowance of all the claims are respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 23, 24, and 26 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ray, III et al. (US Patent No. 4,308,679) in view of Miller et al. (US Patent No. 5,127,743), and Kon et al. (JP 62-62736).

With regarding to claims 23, 24 and 26, the Office Action states:

Ray, III et al discloses a laminated container structure. The laminated structure includes an inner wall of a paperboard or cardboard material and an outer wall of thin pliant material, which are considered to be flexible films, peelable panel, i.e. a strip, is formed in the outer wall material with slits or perforations completely through the outer layer, an adhesive layer between the outer and inner wall for bonding the outer wall material to the inner wall, and a coating a release agent or coating onto the rear surface of the strip to allow for easy peeling without injury to the inner wall material. (Col 4, lines 47-68) Ray, III et al is silent as to the feeding the first and second film into a laminator, extruding a molten plastic layer or adhesive layer between the first and second films, and slitting takes place within 1-24 inches from the pressing step. However, the feeding the first and second film into a laminator and extruding a molten plastic layer or adhesive layer between the first and second films is well known and conventional as shown for example by Miller et al. Miller et al. discloses a method of forming packaging material. The method includes providing a first and second web or film, feeding the films or webs into the laminator, extruding the adhesive between the films, and laminating the two films together. (Col 4, line 51 to Col 5, line 15 and Figure 6)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to feed the first and second film into a laminator and extruding a molten plastic layer or adhesive layer between the first and second films as disclosed by Miller et al in the method of Ray, III et al to provide a method of forming a packaging material quickly and efficiently. (Col 2, lines 33-35) Ray, III et al as modified by Miller et al is silent as to slitting step to form a strip occurs within 1-24 inches from the pressing step. However, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to providing a slitting step to

form a strip within 1-24 inches from the pressing step because the applicant has not disclosed providing a slitting step within 1-24 inches from the pressing provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the slitting step within 1-24 inches or further away and Kon et al discloses a method of forming laminated film, which provide a slitting step or slit wheel just before lamination, (See English Abstract of JP 62-62736) and any distant between the slitting step and the laminating step would perform the same function equally well.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the strip by slitting first web into strips with the slitting step taking place at any position before the laminating step such as within 1-24 inches from the pressing step and pressing the strips onto the second web with the adhesive as disclosed by Kon et al in the method of Ray, III et al as modified by Miller et al because the slitting and laminating steps would perform equally well at any distant.

A proper *prima facie* case of obviousness requires that the prior art reveal a reasonable expectation of success carrying out the proposed combination or modification. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *Id.* A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). A reference may be said to "teach away" from the claimed invention when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D 1130, 1131 (Fed. Cir. 1995).

The Examiner contends that one skilled in the art would be motivated to combine the lamination method disclosed by Miller with the panel of Ray III et al to provide a method of forming packaging material quickly and efficiently. Yet Miller, in several places, specifically teaches away from use of a strip as part of an integral package film. The excerpts from the Miller patent below are illustrative:

- "Stickers on the outside of packages are easily peeled or removed. This renders the promotion useless." (Miller, Col. 1, lns. 63-66).

- “A fairly simply yet widely used method involves the printing of the information directly on to the packaging itself. This has proven to be inefficient, however, because most packaging materials are not conducive to having printing placed upon them other than that relating to the standard label.” (Col. 1, lns. 30-35).
- “There have been many attempts at placing promotional pieces within package walls. However, they all have involved placing the piece within a pouch in the wall, which results in movement of the piece and loss in wall strength, or simply giving the piece to a wall surface.” (Col. 2, lns. 9-14).
- “[T]he amount of printing is limited to the size of the space available on the label.” (Col. 1, lns 45-47).

Further, Miller requires that for a consumer to “gain access to the piece, the package must be opened and destroyed.” (Col. 3, lns. 35-36). The present invention, on the other hand, permits the “strip 510” to be used as a contest piece or prize notification, with its removal causing no harm to the packaging.” (Pat. App., p. 12, lns. 11-12). Further, claim 23 requires that the strip “can be separated from the rest of said flexible packaging film without injury to other layers of said packaging film.” Thus, one skilled in the art would not be motivated to combine Miller with Ray, III to arrive at the presently claimed invention.

Further, Applicant vigorously disagrees with Examiner’s contention that it would have been obvious to provide “a slitting step to form a strip within 1-24 inches from the pressing step because the applicant has not disclosed providing a slitting step within 1-24 inches from the pressing provides an advantage, is used for a particular purpose, or solves a stated problem.” On Page 11, lines 13-19 of the filed patent application, applicants state, “In order to reliably cut through the material without creating problems, two considerations are important: 1) the slitters must be oriented so that the plane of the slit is perpendicular to the plane of the material being slit, with the cutting edge facing the oncoming material squarely, and 2) the slitters must be placed within one to twenty-four (1-24) inches of the laminator nip roller. If these precautions are not observed, the cut film can move unnecessarily, causing overlapping with adjacent pieces or else allowing open spaces between adjacent pieces of film.” Applicant asserts that Examiner’s unsupported contention that “the slitting and laminating steps would perform equally well at any distan[ce]” is in error. Applicant respectfully requests Examiner withdraw the rejection to claims 23, 24 and 26.

Claims 25 and 27 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Ray, III et al. (US Patent No. 4,308,679) in view of Miller et al. (US Patent No. 5,127,743),

and Kartanson (US Patent No. 4,163,684) and as applied to claim 23 above, and further in view of Walker (US Patent No. 3,879,246).

With regarding to claims 25 and 27, the Office Action states:

Ray, III et al as modified above is silent as to applying the adhesive to first web, outer wall material, and the release coating on the second web, inner wall material. However, applying adhesive to the strip is well known and conventional as shown for example by Walker. Walker discloses a method for laminating a foil strip. The method includes applying hot melt adhesive to the foil strip (Col 7, lines 4-13) prior to slitting into strips and would require the release coating to be place on the second web to allow removal, which is considered to be equivalent.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide adhesive on the first web or attachment strip and release coating on the second web or vice versa as disclosed by Walker in the method of Ray, III et al as modified by the combination of references because they are equivalent.

For the same reasons as discussed above regarding the Miller reference, applicant respectfully requests Examiner to withdraw the rejection, because Miller so clearly teaches away from the present invention, one skilled in the art would not be motivated by the Miller reference to arrive at the claimed invention.

Further, regarding Kartanson, Examiner merely states, without any reasoning or citation to the Kartanson reference, that claims 25 and 27 are obvious in view of Miller, Ray III, and Kartanson. In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). One function of the *prima facie* burden is to require the Patent Office to set forth specific objections, which can be met by the applicant, and not just make general rejections. *In re Epstein*, 32 F.3d 1559, 1570, 31 U.S.P.Q.2D 1817, 1820 (Fed. Cir. 1994) (Plager, J., concurring). "The Examiner cannot sit mum, leaving the applicant to shoot

arrows into the dark hoping to somehow hit a secret objection harbored by the Examiner." *In re Oetiker*, 977 F.2d 1443, 1449, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring).

"Presuming *arguendo* that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied upon to arrive at the claimed invention." *Ex Parte Clapp*, 227 USPQ 972 (PTO Bd App. 1985); *In Re Horn*, 203 USPQ 969 (CCPA 1979). Ray III et al discloses pliant material adhered to a rigid material. As shown by Figure 1 of the Ray III patent, the pliant material has a panel defined on one side by a continuous cut 38, on two sides by perforated cuts 24 and on one side by a series of overlapping cuts 32. As shown by Figure 1 of the Walker reference, Walker discloses a plurality of rectangular flexible strips 51 applied to a web of film. The strips 51 require both longitudinal and transverse cutting (see numerals 272 and 281 on Figure 20 of Walker reference) prior to lamination. Kartanson discloses a foil strip adhered to a paper web. Miller discloses a pre-cut promotional piece requiring an application of a first quantity of hot liquid polyethylene followed by a second quantity of hot liquid polyethylene. (See Col. 3, lns. 1-9). The pre-cut promotional piece is then placed between two layers of film. These references, taken together, fail to suggest or teach the claimed invention that provides a method for making a flexible packaging film that permits a strip to be separated from the rest of the film without injury to the other layers of packaging film. Examiner's conclusory statement that the combination of these references would be obvious to one skilled in the art because they are 'equivalent' is vague and fails to provide the necessary suggestion or motivation to combine the art in the stated manner.

The Examiner's failure to provide the necessary suggestion or motivation for the combination of Ray III, Walker, Miller, and Kartanson, other than the aforementioned assertion, creates a presumption that the combination was selected by Examiner to support the obviousness rejection based on improper hindsight. A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by the Applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994). Thus, even if the references could be combined in the manner suggested by the Examiner, the modification or combination is not obvious, because the references fail to suggest or teach the desirability of the modification. Thus, the claimed invention may only be reached using the presently claimed invention as a template to piece together and modify the

teachings of the cited art to teach the presently claimed invention. Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. Thus, it is respectfully submitted that Examiner has not established a prima facie case of obviousness and the rejection of claims 23, 25, and 27 should be withdrawn.

In view of the above, Applicant respectfully submits that the rejection of claims 23-27 is overcome. Accordingly, it is respectfully requested that Examiner withdraw all 103 rejections.

CONCLUSION

In light of the amendments and the arguments made by Applicants above, Applicants submit that all existing claims are now in a condition for allowance. Applicants respectfully request that Examiner withdraw all restrictions and rejections with regard to the above-referenced claims in reliance on one or more of the grounds submitted by Applicants.

If there are any outstanding issues that the Examiner feels may be resolved by way of telephone conference, the Examiner is invited to call Colin Cahoon or Chad Walter at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

The Commissioner is hereby authorized to charge any payments that may be due or credit any overpayments to CARSTENS & CAHOON, L.L.P. Deposit Account 50-0392.

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